

REMARKS/ARGUMENTS

The Office rejected claims 29-42 as being unpatentable over Bodnay (US 4793113) in view of Buecker (6131362). The Applicant respectfully disagrees as, despite the Office's assertions, there is no teaching, suggestion, or motivation to combine the references.

The Office asserts that "it would have been obvious for one skilled in the art to modify the Bodnar '113 chords as taught by Buecker '362 and make the chords 5 sided ... to provide additional strength to the chords." However, the Office apparently failed to appreciate that the Bonder device is a stud (an upright post in the framework of a wall for supporting sheets of lath, wallboard, or similar material) and is specifically designed to minimize the amount and thickness of the material used in forming it. As such, it is not adapted to function as a joist and modifying it as proposed by the Office would render it unsuitable for its intended purpose. In the case of *In re Gorden*, 733 F.2d 900 (Fed. Cir. 1984), the court stated that if a proposed modification would render the invention unsatisfactory for its intended purpose, there is no suggestion to make the modification. Here, the general knowledge of one of ordinary skill in the art would have led him away from adding the 5 sided design since such an addition would have rendered the resulting member unsuitable for its intended purpose - to minimize the thickness.

Additionally, a finding of obviousness requires a reasonable expectation of success (*In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)). In this case, one of ordinary skill in the art would not have found a reasonable expectation of success in a joist with an open area as taught by Bodnar. A joist with such an open area would have been expected to fail.

Despite the non-obviousness of making the combination suggested by the Examiner, the applicant has amended claim 29 to more particularly point out that the weight bearing element is a joist.

The applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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